<u>REMARKS</u>

The present application was filed on May 31, 2001 with claims 1-35. Claims 1-36 remain pending and claims 1, 17, 33, 34 and 36 are the pending independent claims. Independent claims 1, 17, 34 and 36 have been amended.

In the outstanding Office Action, the Examiner: (i) objected to the drawings; (ii) rejected claims 1, 2, 5-8, 17, 18, 21-24 and 33-36 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,256,773 to Bowman-Amuah (hereinafter "Bowman"); and (iii) rejected claims 3, 4, 9-16, 19, 20 and 25-32 under 35 U.S.C. §103(a) as being unpatentable over Bowman in view of U.S. Patent No. 6,226,792 to Goiffon et al. (hereinafter "Goiffon").

Regarding the drawing objection, Applicant has resubmitted amended FIG. 7 with a header indicating "Replacement Sheet." It is respectfully requested that the proposed change be entered and the objection be withdrawn.

Regarding the §102(e) rejection of claims 1, 2, 5-8, 17, 18, 21-24 and 33-36, Applicant respectfully asserts that Bowman fails to teach or suggest all of the limitations in claims 1, 2, 5-8, 17, 18, 21-24 and 33-36, for at least the reasons presented below.

Applicant first points out that the Examiner indicated in the final Office Action that independent claims 33 and 36 were rejected under the same rationale of claims 1 and 2 because they recite the limitations of claims 1 and 2. The Examiner is incorrect. Claim 2 recites "at least one" step from a plurality of steps, and in rejecting claim 2, the Examiner only provides support for the rejection of a single step. <u>Independent claims 33 and 36 recite each step of claim 2 and the Examiner has not provided proper support in order to sustain a rejection of each of these steps.</u>

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicant asserts that the rejection based on Bowman does not meet this basic legal requirement, as will be explained below.

By way of example, amended independent claim 1 recites a method of configuring software, the method comprising utilizing a common software configuration markup language in a computer

system including at least one server which is connected to a plurality of client computers, the server having a memory for storing product elements which may be linked together to form at least one version of a software package, and further for storing processes usable by the clients to at least one of maintain the product elements and develop new product elements, and tools usable by the clients to at least one of define, maintain and update relations between product elements. The common software configuration markup language is useable by a cooperating team on the plurality of client computers to define a project, perform a memory access to at least one of product elements and packages, map one or more of the processes and tools to one or more library systems, and define relations between the product elements, allowing for the editing of product elements at individual client computers in at least one language independent of the common software configuration markup language to form different versions of a software package. Independent claims 17, 33 and 34 recite at least some similar limitations.

As noted above, Applicant has added that the common configuration markup language is useable by a cooperating team on the plurality of client computers to perform certain functions in independent claims 1, 17 and 34 to further clarify the use of the common software configuration markup language of the claimed invention. Additionally, Applicant has added that the functions performed by the cooperating team on the plurality of client computers allows for the editing of product elements at individual client computers in at least one language independent of the common software configuration software language to form different versions of a software package. Support for the amendments can be found on pages 3-5 of the Specification.

The Office Action suggests that the mention of HTML in Bowman is sufficient to reject the "common software configuration markup language," of the claimed invention. However, Applicant points out that Bowman merely states that "[a] preferred embodiment of [Bowman] utilizes HyperText Markup Language (HTML) to implement documents on the Internet . . . ." No where does Bowman disclose "a common software configuration markup language" that is "useable by a cooperating team on the plurality of client computers to define a project, perform a memory access to at least one of product elements and packages, map one or more of the processes and tools to one or more library systems, and define relations between the product elements, allowing for the editing

of product elements at individual client computers in at least one language independent of the common software configuration markup language to form different versions of a software package," as in the claimed invention.

Furthermore, Bowman even discredits the use of a markup language such as HTML by immediately going on to state, at column 8, lines 31-43, the problems with HTML:
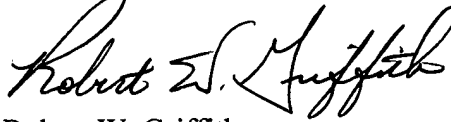
> To date, Web development tools have been limited in their ability to create dynamic Web applications which span from client to server and interoperate with existing computing resources. Until recently, HTML has been the dominant technology used in development of Web-based solutions. However, HTME [sic] has proven to be inadequate in the following areas: [p]oor performance; [r]estricted user interface capabilities; [c]an only produce static Web pages; [l]ack of interoperability with existing applications and data; and [i]nability to scale.

Dependent claims 2, 5-8, 18, 21-24 and 35 are patentable at least by virtue of their dependency from independent claims 1, 17 and 34, and also recite patentable subject matter in their own right. Thus, Applicant asserts that Bowman does not meet the basic legal requirement of the above-cited Federal Circuit decision in *Verdegaal Bros. v. Union Oil Co. of California.* Accordingly, withdrawal of the §102(e) rejection of claims 1, 2, 5-8, 17, 18, 21-24 and 33-36 is respectfully requested.

Regarding the §103(a) rejection of claims 3, 4, 9-16, 19, 20 and 25-32, Applicant asserts that said claims are patentable over the Bowman/Goiffon combination since Goiffon fails to remedy the above-mentioned deficiencies of Bowman. Therefore, Applicant asserts that dependent claims 3, 4, 9-16, 19, 20 and 25-32 are patentable by virtue of their dependency from independent claims 1 and 17, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the 103(a) rejection of claims 3, 4, 9-16, 19, 20 and 25-32 is respectfully requested.

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In view of the above, Applicant believes that claims 1-36 are in condition for allowance, and respectfully requests withdrawal of the various §102(e) and §103(a) rejections.

Respectfully submitted,

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Encl: FIG. 7 - Replacement Sheet